

70. (Twice Amended) The game playing method of claim 66[8] wherein, in the actuating step (C), said second base game outcome can include a repeat bonus opportunity to play said base or bonus game of chance upon the appearance of said first or another predetermined base game outcome in said base game of chance.

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REMARKS

The following claims were pending prior to this Amendment: 1-4, 9, 10, 12-14, 19-40, 45-50, 52, 54, 56, 65, 66, 70, 74, 76, and 77. This Amendment amends claims 49 and 70, and with this amendment, the same numbered claims remain pending.

10 With regard to claims 49 and 70, the Examiner objected to these claims as being dependent on cancelled claims. The applicant has amended these claims to render them dependent on a pending parent claim.

With regard to claims 1-4, 9, 10, 12-14, 19-36, 50, 52, 54, 56, 65, 66, and 70, the Examiner rejected these claims as being obvious over Mayeroff '484 in view of the British
15 Stanley reference and the Crawford reference.

The applicant respectfully submits that this rejection turns on the Examiner's stated view that Stanley teaches as follows:

20 Stanley teaches of an amusement apparatus that has a first type of game that upon a predetermined completion will initialize a second type of game and success on the second game will lead to a further game on the first game (Abstract). In the disclosed apparatus, the second game of chance can lead to an alteration of the result of the first game of chance (page 5, lines 21-23) by obtaining a predetermined alteration outcome as a result of the game, such as rotating the reels (FIG 4, reference 10, NUDGES) and changing the first game outcome in the first game outcome display and providing a chance-improving
25 outcome as the reels can then be moved to a winning combination. Further another alteration of the first game outcome provided by the second game would be to spin until a

win is achieved (FIG 4, reference 10, SPIN A WIN). The second game of chance is connected to the first game and is activated upon a predetermined completion of the first game (Abstract). Stanley discloses that upon success in the second game of chance, the first game of chance can again be replayed. Stanley also discloses an additional award can be won from the second game based upon a predetermined outcome (FIG 4, reference 10, win L3) thereby increasing the total award provided to the player. Though Stanley does not distinctly disclose that upon a first game of chance being played again, the second game of chance is again activated, this is strongly implied by Stanley in that the bonus game allows the play of the first game to again occur and thus it would be inherent that the same payable is used. Therefore, if the “nudges” or “spin until a win” are obtained from the bonus game in order to replay the first game result in a predetermined completion associated with the bonus game, the bonus game would axiomatically be re-enacted.

Office Action at 4 (emphasis added). The Examiner reiterated her views on this matter in the response to the Applicant’s argument, at 8. The applicant most respectfully disagrees and has submitted the attached Declaration of Loren Nelson as evidence showing that the Stanley reference: (i) does not enable and provide the requisite teaching noted by the Examiner above; and (ii) does not inherently teach or even imply the particular payable and re-enacting of the bonus game as asserted in the Office Action.

With regard to the need for the prior art to teach the feature for which it is cited, the Federal Circuit has explained that a reference is prior art “for all that it teaches.” *Beckman Instruments, Inc., v. LKB Productur AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989). Of course, a reference only teaches that which it enables. As a result: “The prior art must be enabling.” *Rockwell Int’l Corp. v. U.S.*, 147 F.3d 1358 (Fed. Cir. 1998).

In this regard, the test for enablement is not just whether an engineer in the art could make such a machine eventually. It is whether the disclosure provides sufficient information for ordinary artisan to make and use the disclosed features without undue experimentation. *In re Wands*, 858 F. 2d 731, 737 (Fed. Cir. 1988).

As the attached Declaration explains:

1. the Stanley reference includes only four figures of limited external views of what the conceived game might look like, and its "specification" of how to make the conceived game is consists of only 3 pages of double and triples spaced text;
- 5 2. the Stanley reference does not even include basic block diagrams of any type for the internal components, structure, firmware, software, etc., required to make and use a device that would perform the uses (concepts) cited by the Examiner from the Stanley reference;
3. the entire pertinent disclosure is two small lines in the Abstract, three lines in the
10 specification, and associated but very limited high level physical structure on the outside of a purported machine;
4. the Stanley reference only suggests how a game might be developed at a very high conceptual level, leaving it to the reader to have to develop nearly the entire machine; and
5. in order to make a game of the type asserted by the Examiner to be taught by Stanley, an
15 engineer artisan in the field would have to start from scratch, and the amount of time required to experiment and develop these features in the Stanley reference would be at least 1.5 man years.

As the attached Declaration therefore explains with detailed factual support and explanation, the Stanley reference really does not teach one skilled in the art at the time of invention to make and
20 use the cited features without a great deal of experimentation and development.

The applicant respectfully submits that if Stanley were an enabling disclosure of the features in issue, then a patent applicant in the gaming industry would need to include very little

indeed in order to procure a U.S. patent meeting the enablement requirement. All an applicant need do is dream up what a gaming machine might look like on the outside, include a wish list of features (or uses) that the applicant would like to have external elements machine perform, and then claim that those features or uses – without any teaching of how to really make such a gaming machine. The applicant respectfully submits that this would be contrary to the very basis of the U.S. patent system, in which the inventor provides an enabling teaching of how to both make and use the inventor's invention without undue experimentation as the quid pro quo for a published patent and right to exclude based on that teaching.

In addition, even if the Stanley enabled the features expressly referenced in the disclosure, the applicants respectfully submit that the Stanley reference does not inherently disclose a payable of the type stated in the Office Action. As the Federal Circuit has held, a feature is inherent in a disclosure only if “the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Industries, Inc. v. Top U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002). “Inherency does not embrace probabilities or possibilities.” *Id.* at 1296.

As the attached Declaration explains (at ¶¶ 11-12), the type of payable identified in the Office Action is not necessarily present in (much less enabled or taught by) the Stanley reference. Stanley therefore does not inherently teach or disclose such a payable.

In this regard, inherent inclusion of such a payable in Stanley is insufficient in the context of the present obviousness rejection under Section 103. As the Federal Circuit has explained, “That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown. Such a retrospective view of inherency is not a substitute for some teaching or

suggestion supporting an obviousness rejection.” *In re Rijckaert*, 3 F.3d 1531, 1534 (Fed. Cir. 1993) (additional citations omitted). As the attached Declaration also shows, to one skilled in the art, it is unknown to those skilled in the art whether the payable included in Stanley would provide the features asserted by the Examiner.

5 The applicants therefore respectfully submit that Stanley does not provide the requisite teaching for a variety of independent reasons. Stanley does not adequately teach how to make and use the cited high level concepts it recites; Stanley does not inherently include the identified payable; and Stanley does not make known (much less enable) the identified payable to one skilled in the art. Thus, for a variety of independently sufficient reasons, Stanley does not
10 provide the requisite teaching, and the asserted combination is inadequate to yield the claimed subject matter. Since the asserted combination does not yield the claimed subject matter, it cannot render the claimed subject matter obvious as a matter of law.

 The applicant notes that this same logic applies to the Examiner’s rejection of all the claims in this case, including the rejection of claims 37-40, 45-49, 74, 76, and 77 as being
15 obvious over Mayeroff, Stanley, Crawford, and Kaku. In connection with the rejection of these claims, the Examiner explained that what Mayeroff, Stanley, and Crawford “disclose, teach, and/or suggest has been discussed above and is incorporated herein by reference.” Office Action at 6. The applicant therefore submits that all claims are allowable for the reasons noted above with regard to the lack of teachings in the Stanley reference.

20 With regard to the Examiner’s combination of features from Mayeroff and Stanley to yield certain aspects of the claimed subject matter, the Examiner stated:

Applicant notes that an ongoing motivation of the gaming industry is to develop slot type machines that are more exciting to play and thus more likely to be played and generate revenue. Stanley teaches of an amusement device where play is more exciting given the fact that the bonus round can alter the base game round and there are such bonus awards as spin until a wind and nudge. With these additional features, the bonus game would become much more exciting to the user, as there is higher anticipation of a positive result from the bonus. By incorporating an apparatus that provides the user with a higher anticipation of an award and greater excitement, the lure of the machine is greatly increased and the goal of the gaming industry is met as the slot machine is more exciting to play and thus more likely to be played and generate revenues. For these reasons, it would have been obvious to one skilled in the art at the time of invention to incorporate the bonus round teachings of Stanley in the apparatus of Mayeroff to create a game of chance where the bonus round is more exciting and enticing to the user.

15 Office Action at 5.

The Examiner stated similarly – that the generalized goal of making a game more exciting in the industry provides the requisite motivation to combine the particular, selected features from Mayeroff, Stanley, and Crawford to yield the claimed subject matter:

Further, it well known in the art, when a user perceives a greater chance of winning on a gaming machine, the user is more likely to participate in play of that machine. By incorporating the symbol save feature of Crawford into the apparatus of Mayeroff in view of Stanley, the user would get even more enjoyment out of the bonus round as it would be possible to save a bonus feature for use at a later time. Therefore, it would have been obvious to one skilled in the art at the time of invention to incorporate the teachings of Crawford into the apparatus of Mayeroff in view of Stanley to create a bank in which the user could store a symbol obtained in the bonus round for use in the primary round at a later time in order to give the user a feeling of better control over their own fate in the game, thus giving a perception of a greater likelihood of award winnings.

30 *Id.*

The applicant respectfully disagrees that there is sufficient evidence of motivation or suggestion to combine in the record. The pertinent motivation or suggestion must at least include a motivation or suggestion to select the particular features from the cited references and then combine those selected features in order to yield the claimed subject matter. E.g., *C.R.*

Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1351 (Fed. Cir. 1998). The generalized motivation in the industry to provide more exciting games is only one of many motivations in the industry, and it is not a motivation to select the asserted features from these two or three references and then combine them, much less in the fashion invented and claimed by the applicant. If generalized motivations to improve (here, add excitement) were sufficient to provide the requisite motivation to combine, then rare would be patentable inventions indeed, as most are made in an industry in which at least one among many known goals in the industry is arguably more likely satisfy by claimed subject matter being sought by the applicant.

With focus on motivation to select from and combine these references in the fashion asserted, the applicant respectfully submits that there is no such motivation or suggestion in the record. The applicant submits that the present combination is the result of picking and choosing from prior art references to yield the highly unique claimed subject matter, without any motivation or suggestion in the record for doing so.

Similarly, with regard to method claims 65, 66, and 70, the Examiner urged the same combination as noted above, and for the same reasons. For the same reasons noted above, the applicants submit that the combination is not supported by the record and these claims are allowable.

With regard to claims 37-40, 45-49, 74, 76, and 77, the Examiner rejected these claims as obvious over a combination of select features from four references: (i) Mayeroff, (ii) Stanley, (iii) Crawford, and (iv) Kaku. In this rejection, the Examiner stated that "What Mayeroff, Stanley, and Crawford disclose, teach, and/or suggest as has been discussed above." Office Action at 6. With regard to adding features from the fourth reference, Kaku, to the combination,

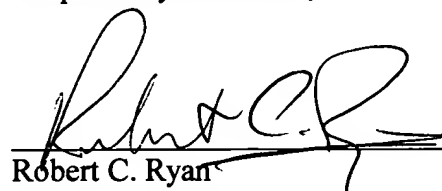
the Examiner cited Kaku's concentric disks and argued essentially as stated above – that adding Kaku would be obvious in order to make the game more exciting.

Again, the applicant submits that there is no suggestion or motivation for the asserted combination of select features from these four references (much less the underlying combination
5 of three references for the reasons note above). The applicant respectfully submits that this combination of select features from four quite distinct references constitutes impermissible hindsight picking and choosing from the prior art, and the number of references involved is merely practical evidence that this is so. It would be one thing for the Examiner to pick features from four references and assert the combination were obvious if there were such a suggestion or
10 motivation in the record. On this record, however, there is no suggestion or motivation to do so. The applicant therefore submits that these claims, 37-40, 45-49, 74, 76, and 77, are therefore allowable.

The applicant therefore submits that all claims are allowable. The applicant's counsel requests the opportunity to interview these claims and will call the Examiner to request such an
15 interview. In the event the Examiner has any questions or concerns in the meantime, the applicant requests that the Examiner please call the applicant's counsel at the number set forth below.

Respectfully submitted,

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